

### Remarks

Applicant gratefully acknowledges the telephonic interviews of July 22, 2010 and August 31, 2010. In the July 22 discussion, Applicant's attorney Carla L. Gannon raised the possibility of amending the claims to require the wall be load bearing, but the Examiner expressed her belief that this was taught by the prior art. In the August 31 discussion, Attorney Gannon suggested amending the claims to recite wood tying structures, to distinguish over the composite tying structures taught by Mulford. The Examiner indicated that wood tying structures are known in the art. No claim allowance was agreed upon in either interview.

The Office Action mailed June 22, 2010, has been carefully considered. After such consideration, no claims have been amended or cancelled. Claims 1-3 and 5-11; 12-18, 20 and 25; and 26-27, 29-41, 43 and 48 remain in the case with none of the claims currently being allowed.

### Rejection of Claims 1-3, 5-18, 20, 25-27, 29-41, 43 and 48 Under 35 USC §103(a)

The Office rejects the above claims as being unpatentable over Gebhardt in view of Mulford and ASTM E119-95a (the "Omega Point" reference provided by Applicant). It is the Office's position that the claimed invention merely combines certain structural elements of the Omega Point and Mulford references, and this resulting structure is suitable for use in Gebhardt.

In response, Applicant respectfully points out that it is well settled that obviousness requires:

- 1) Motivation to combine;<sup>1</sup>
- 1) Prior art elements that are capable of being combined;<sup>2</sup> and
- 2) A resulting combination that would have worked for its intended purpose.<sup>3</sup>

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<sup>1</sup> *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)

<sup>2</sup> See discussion of *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-40 (2007) in *DuPuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 131, 14-15 (Fed. Cir. 2009).

<sup>3</sup> *Id.*

For at least the reasons articulated herein, it is believed that these requirements have not been met.

### **There is no motivation for one to combine Mulford and Omega Point with Gebhardt**

Gebhardt's multi-level building is a plurality of "individual contiguous units"<sup>4</sup> wherein the "party wall structures can be lowered into place between the roofs of contiguous units."<sup>5</sup> In other words, a free-standing, structure is first assembled of "independently structurally sound"<sup>6</sup> units, then the pre-constructed party walls are introduced through gaps in the roof of the adjacent units and slid into position between adjacent units.

There would be no reason to employ load-bearing party walls with Gebhardt since Gebhardt's structure is structurally sound without the party walls. Such an arrangement would be redundant and cost-prohibitive and contrary to the design philosophy of Gebhardt.

### **Mulford and Omega Point are not capable of being combined with Gebhardt**

The separation walls of the present inventions are constructed as part of the construction of a multi-level building and are not structurally separate contrary to Gebhardt. Thus, the separation walls of the present inventions cannot be picked up by a crane and slid between units. Figure 3 illustrates that the separation wall of the present inventions is part of the overall building structure. In short, the references are not capable of being combined without creating substantial technical obstacles.

### **The combination of Mulford, Omega Point and Gebhardt would not work for the intended purpose**

After Gebhardt's party walls are lowered into position, they are attached to adjoining units with clips, which are fabricated from a low temperature melting metal. Low-melt clips are employed "to permit the floor decks or roof sections to **separate** from the party wall in any unit where a fire might occur rather than have such floor decks or roof sections pull down the fire-resistant party wall."<sup>7</sup> [Emphasis added]

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<sup>4</sup> Col. 2, lines 21-22.

<sup>5</sup> Col. 2, lines 23-24.

<sup>6</sup> Col. 7, line 40.

<sup>7</sup> Col. 8, lines 52-58.

In other words, Gebhardt requires party walls that will disengage from the burning unit in the event of a fire, thereby sacrificing the burning unit but leaving the adjacent unit intact. The walls of the present inventions, however, are specifically designed to be load bearing, and remain part of the multi-level structure in the event of a fire, so as to maintain the structural integrity of the entire structure during a fire. If one were to introduce the load-bearing separation walls of the present inventions into Gebhardt's structure, as the Office has suggested, the result would be party walls which do not separate from the burning unit and which would compromise the structural integrity of the adjacent floor decks and roof sections of Gebhardt's adjacent load bearing walls. It is respectfully submitted that Gebhardt's design, which sacrifices the burning unit, is a completely different approach to the present inventions' design, which is intended to provide time to save the entire structure.

For at least the reasons discussed above, Applicant believes that the Office's rejections should be withdrawn, and the claims should be allowed. However, if Applicant's attorney can assist in resolving any issue, the opportunity for a telephone interview would be welcomed.

Since no claims have been amended, Applicant respectfully points out that new issues have not been raised, and that a Request for Continued Examination should not be necessary if the Examiner believes that a new search is necessary.

Respectfully submitted,



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